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EXAMINER	
REAGAN, JAMES A	
ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CLIFF BURKE THOMPSON and DAVID KIRBY

Appeal No. 2005-0386
Application 09/576,462

ON BRIEF

Before HAIRSTON, GROSS, and MACDONALD, **Administrative Patent Judges.**

MACDONALD, **Administrative Patent Judge.**

REMAND TO THE EXAMINER

We remand this application to the Examiner for consideration of the following matters.

I. How the Pool et al. patent and/or Kroenke reference meet the limitations of claims 1-53 and 55-62 in the rejections under 35 U.S.C. § 103?

II. Whether a rejection of claim 47 under 35 U.S.C. § 112, second paragraph is appropriate?

III. Whether a rejection of claims 24-26 and 46-50 under 35 U.S.C. § 101 is appropriate?

I. How the Pool et al. (Pool) patent and/or Kroenke reference meet the limitations of claims 1-53 and 55-62 in the rejections under 35 U.S.C. § 103?

The rejections include a broad-brush discussion citing sections of the Pool patent as corresponding to sections of Appellants' claims. However, the rejection does not point out how numerous features within the sections of the claims are met by specific features within the Pool patent and/or Kroenke reference. We point out a step within claim 1 as exemplary.

As to the inputting step of claim 1, the rejection fails to indicate what in the Pool patent corresponds to "invoice data", "import/export transaction," "first terminal", and "product identifier." This lack of detail is not cured by the Examiner's broad-brush citation to the Kroenke reference. We request that

the Examiner specifically point out how the limitations of the claims are met by the Pool patent and/or Kroenke reference. The Examiner continues this broad-brush treatment in the response section of the answer. We point out page 30 of the answer as exemplary. Without a detailed discussion of how the Pool et al. (Pool) patent and/or Kroenke reference meet the limitations of claims 1-53 and 55-62 in the rejections it is left to this panel to guess at the Examiner's intent. We do not choose to do so.

Additionally, Appellants have repeatedly pointed out that any "means plus function" language of the claims must be interpreted under **In re Donaldson**. We agree. We request that the Examiner require Appellants to identify every means plus function and step plus function in the claims and set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawing, if any, by reference characters. Appellants have raised this issue, and this panel does not choose to guess at the intended coverage of Appellants' claim language.

Accordingly, we *remand* for consideration of this issue.

II. Whether a rejection of claim 47 under 35 U.S.C. § 112, second paragraph is appropriate?

We have reviewed claim 47 and request that the Examiner explain how this claim meets the requirement of 35 U.S.C. § 112, second paragraph (i.e. why there is no antecedent basis problem in claim 47). We are unable to find a "computer program product" in claim 45 from which claim 47 depends.

Accordingly, we *remand* for consideration of this issue.

III. Whether a rejection of claims 24-26 and 46-50 under 35 U.S.C. § 101 is appropriate?

We have reviewed claims 24-26 and 46-50 and find that these claims are directed to a "computer program" per se. The language of claim 24 recites "adaptable for storage on a computer readable medium". We find that such language does not require that the computer program product be on a computer readable medium. Rather, this language merely requires that the computer program be capable of storage at a current or later time. We request that the Examiner explain why and how these claims meet the requirement of 35 U.S.C. § 101.

Accordingly, we *remand* for consideration of this issue.

Conclusion

If reconsideration by the examiner does not promptly result in the withdrawal of all pending rejections, the examiner must return this application to the jurisdiction of the board so that the appeal may be restored to its existing place in the order in which appeals are decided. In the event that the examiner returns this application to the jurisdiction of the board following reconsideration, a new appeal number will be assigned. However, a new appeal fee will not be required.

This application, by virtue of its Special status, requires ***immediate*** action by the examiner. *See* MPEP § 708.01(d). The Board of Patent Appeals and Interferences ***must*** be informed promptly of any action affecting the appeal in this case, including reopening of prosecution, allowance and/or abandonment of the application.

REMAND

KENNETH W. HAIRSTON)
Administrative Patent Judge)
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ANITA PELLMAN GROSS) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
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ALLEN R. MACDONALD)
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